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OFFICE OF PETITIONS

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

In re Application of
Kiyoshi Sato, Toshinori Watanabe, Hideki Gochou,
Kiyoshi Kobayashi, Toru Takahashi, Hisayuki
Yazawa, and Masaki Ikegami
Application No. 09/802,314
Filed: March 8, 2001
Attorney Docket No. 9281/3900
Title: THIN-FILM MAGNETIC HEAD
APPROPRIATELY SUPPRESSING SIDE
FRINGING AND METHOD FOR FABRICATING
THE SAME

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed August 16, 2001.

The petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on March 8, 2001, without an executed oath or declaration and identifying Kiyoshi Sato, Toshinori Watanabe, Hideki Gochou, Kiyoshi Kobayashi, Toru Takahashi, Hisayuki Yazawa, and Masaki Ikegami as joint inventors. Accordingly, on April 13, 2001, a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" was mailed, requiring an executed oath or declaration in compliance with §1.63, as well as the statutory basic filing fee of \$710, the fee for filing a late oath or declaration of \$130. This Notice set a two-month period for reply.

¹ A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR 1.63.

In reply, applicant filed the instant petition (and fee) and paid the surcharge for late filing of the declaration, as well as the filing fee². To make timely this reply, applicant also filed a request for a two (2) month extension of time (and fee, which was also charged to the Deposit Account). Accompanying the petition was a statement by attorney Jasper Dockrey, a declaration executed by the first six named inventors, unsigned copies of the employment agreement between the non-signing inventor and his employer, Alps Electric Company (Alps), a declaration executed by Toshiya Takemoto, the Business Planning Office Manager of the Magnetic Devices Division of Alps, and a declaration executed by Junji Kobayashi, an employee of the Engineering Administration Department of the Magnetic Division of Alps who is also "in charge of patents".

Rule 47 applicant has met requirements (1) - (5) above.

The statement of Jasper Dockrey, as well as the declarations of Toshiya Takemoto and Junji Kobayashi establish that the non-signing inventor died before his signature could be obtained on the declaration. The two declarants contacted the heirs of the deceased, Hiromi Ikegami and Chiaki Ikegami, and requested that they execute the declaration on behalf of the deceased. Unfortunately, when the two heirs met with Mr. Takemoto at Alps and were presented with the complete application, both refused to sign the declaration.

Regarding item (6) above, the petitioner has not included an acceptable oath or declaration. The submitted declaration is deficient in that it fails to list the name, post office address, and citizenship of the non-signing inventor. The declaration submitted along with the instant petition does not list the deceased non-signing inventor, but rather lists both of his heirs as joint inventors. This is not acceptable, in that 37 CFR 1.63(a)(2) requires that each inventor be identified on the declaration. In situations where an inventor has died and his heirs or legal representative is required to execute the document on his behalf, the proper course of action is explained in the section of 65 FR 54604 included below, and should assist the petitioner in drafting his renewed petition.

Section 1.44: Section 1.44 is removed and reserved to eliminate the requirement that proof of the power or authority of the legal representative be recorded in the Office or filed in an application under §§ 1.42 or 1.43. Although proof of authority is no longer required to be submitted to the Office, applicants may wish to consider obtaining proof of authority of the legal representative and recording such a document with any assignment documents for record-keeping purposes.

In order to make a patent application on behalf of a deceased or incapacitated inventor, the legal representative may now simply sign the § 1.63 oath or declaration (which includes the full name and citizenship of the deceased inventor as well as the residence and mailing address, if not provided on an application data sheet) as the legal representative of the particular inventor with the title "Legal Representative" placed under the signature. In other words, in a signature block containing the deceased or incapacitated inventor's name, the legal representative will sign "for" the deceased or incapacitated inventor supplying the representative's name and stating that he or she is the legal representative. In addition, the legal representative should provide his or her mailing address so that the Office can directly communicate with the legal representative if necessary. See § 1.64(b).

The deletion of the § 1.44 proof requirement for the legal representative of §§ 1.42 and 1.43 will be effective on the date of publication in the Federal Register with § 1.64 as to all pending papers under §§ 1.42 and 1.43 that have not had the proof requirement satisfied. If a requirement for proof of authority has been made by an examiner, the requirement can be satisfied by a reply referencing this final rule.

²These fees have been charged to petitioner's Deposit Account, as authorized in the petition.

Thus, on renewed petition, applicant must submit a declaration that is in compliance with 37 CFR 1.63.

Further correspondence with respect to this matter should be addressed as follows:

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

B. B. M. D. L. C.

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Office of the Deputy Commissioner
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